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HP Docket No. 10011462-1

**REMARKS**

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Office have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 9, 15, 23, and 30-31 have been amended. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

**Election/Restriction**

Applicants acknowledge the withdrawal of the prior restriction requirement. However, Applicants disagree with the Office's position that the claimed invention in claim 30 would be an obvious variation of the other independent claims, because "applicant's specification has not pointed out any novel advantage to having either program launch the printer driver" (Office Action, p.2). The specification discloses:

"Next, in box 110 and identified in FIG. 2 as event C, the virtual driver 60 launches the printing agent 58. Therefore, the virtual driver 60 is used as a means to launch the printing agent 58. This arrangement is used to bypass algorithms contained in many operating systems 54 that may preclude the launching of the printing agent 58 directly from the application 56, especially after the print command is selected. However, in an alternative embodiment of the present invention, the printing agent 58 is launched directly by the user." (specification, p.10, ln. 24-30; emphasis added)

**Rejections**

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Rejection Under 35 USC §103

Claims 1-2, 6-7, 9, 13-16, 20-23, 25-27, and 31-36 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 5,692,111 to Marbry et al. ("Marbry") and further in view of U.S. patent 6,335,795 to Neuhaard et al. ("Neuhaard"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

More recently, the Supreme Court, quoting *In Re Kahn*, 441 F.3d, 977, 988 (CA Fed. 2006), has clarified that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *Teleflex Inc. v. KSR Int'l Co.*, 82 USPQ2d 1385, 1396 (S.Ct. 2007).

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The rejection of independent claim 1, and its dependent claims 2, 6-7, and 32-34, is respectfully traversed for at least the following reasons. Claim 1 recites:

“1. (Currently amended) A method of determining information regarding at least one physical printer available to receive a print job from a client computer, comprising:  
calling a general printer driver, through which the print job is passed, directly from an application executed by the client computer;  
transmitting a query from the client computer to a server via a network for an identification of the at least one available physical printer;  
receiving the identification of the at least one available physical printer from the server;  
selecting a single one of the identified physical printers to receive the print job;  
after the selecting, downloading from the server a file used to convert print data into a format specific to the selected physical printer; and  
wherein the general printer driver is accessible as a destination printer in a print menu of the application, and wherein the general printer driver is configured to launch a printing agent different from the general printer driver to perform the transmitting when the general printer driver is selected as the destination printer in the print menu.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

With regard to the feature of (a) a general printer driver through which the print job is passed being configured to launch (b) a printing agent different from the general printer driver (c) to perform the transmitting of a query from the client computer to a server for identification of an available printer (d) when the general printer driver is selected as the destination printer in the print menu, the Office admits that the Iwata and Marbry references do not transmit a query, but states that “Neuhard discloses ... that clients can query a server for available printers” (Office Action, p.4). However, the cited references, taken in combination, fail to teach or suggest a complete construction that includes all the aspects (a)-(d) of this feature of claim 1.

With regard to a query from a client computer to a server for identification of an available printer, the Neuhard reference discloses client computers 4a,b,c and InfoPrint MPC Server 6 (Fig. 1). As taught by the reference:

“The job ticket 40 may be created on the client computer 4a, b, c using the InfoPrint Submit software 10 installed thereon. The InfoPrint Submit software 10 includes a graphical user interface (GUI) displayed on the monitor 14a, b, c that the user may use to create the job ticket

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40. The InfoPrint Submit software 10 then translates the job ticket 40 created thereby to a format compatible with the InfoPrint MPC server 6.” (col. 6, ln. 66 – col. 7, ln. 6; emphasis added)

As further taught by the Neuhard reference with reference to Fig. 13:

“a GUI program 180, which in preferred embodiments is included in the InfoPrint Submit software 10, interfaces with other programs and objects to obtain information on the print attributes available in the network printing system 2. The GUI program 180 updates the GUI 60 with the obtained print attributes by generating data to the monitor 14a, b, c to cause the display of the available print attributes in the GUI 60. In the preferred embodiment of FIG. 13, the GUI program 180 queries a status object 182 for available printer models, the media available for a selected printer model, and the printers 28, 30, 31, 32 available in the network printing system 2 for a selected printer model and media. The status object 182, in turn, queries a cache 184 or the InfoPrint MPC server 6 to obtain information on the printer models available in the network printing system 2. The status object 182 then constructs a model object for each printer model type supported in the network printing system 2. In the preferred embodiment of FIG. 13, the status object 182 constructs an InfoPrint 4000 model object 188, an InfoPrint 60 model object 190, an InfoColor 70 model object 192, and a Printer model object 194. In alternative embodiments, different model objects would be created if different printer models are attached to the network printing system 2. However, only one object is created for a specific model, even if multiple printers of a particular printer model type are attached to the network printing system 2.” (col. 12, ln. 16-42; emphasis added)

Thus the Neuhard reference fails to teach or suggest the limitation that the transmission of the query from the client computer to the server is performed by a printing agent launched by a general printer driver through which the print job is passed. Any query of Neubold is performed by the status object 182, which is called directly from the application (i.e. the InfoPrint Submit software 10 on client computer 4). As understood from Figs. 14a,b,c (“flowcharts illustrating a preferred embodiment of how the GUI program 180 obtains information on the model, media and printers available in the network printing system 2”; col. 13, ln. 3-6), status object 182 is not a general printer driver, nor is the print job ever passed through the status object 182. Nor does status object 182 launch any printing agent that performs the transmitting of the query; rather, the Neuhard reference teaches that the status object 182 itself performs the query (e.g. block 218 of Fig. 14a “represents the client computer 4a,b,c querying the InfoPrint MPC server 6 for the available printer models”; col. 13, ln. 25-27). The Neubold reference does not disclose, teach, or

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suggest any printing agent different from the general printer driver and the application.

Furthermore, the Neuhard reference fails to teach or suggest the limitation that the general printer driver is selected as the destination printer in a print menu of the application. The InfoPrint Submit job ticket software has no print menu at all. Instead, the reference teaches that “the user may ... submit the job ticket 40 to the printer services manager 6 using the Save and Submit Job functions displayed in the Ticket submenu 80” (col. 8, ln. 64-67; emphasis added). However, to whatever extent, if any, that the Ticket submenu may, arguendo, be considered to be a print menu, the Save and Submit job function cannot be executed until after the fields on pages 70a-e (including Print page 70b, Fig. 5a) have been filled in; and it is during the process of filling in these fields that the status object 182 queries the InfoPrint MPC server 6. In addition, because the Neuhard reference fails to teach or suggest the limitation that the general printer driver is selected as the destination printer in a print menu of the application, it cannot teach or suggest that the query is transmitted when the general printer driver is selected as the destination printer.

The Office does not cite the Marbry reference as teaching any of the limitations discussed above, and Applicants believe the Marbry reference teaches no such limitations. The Marbry reference is cited only for “the downloading of a file to convert data” (Office Action, p.4).

The Office cites the Iwata reference, however, as teaching a general printer driver, “accessible as a destination printer in a print menu”, “configured to launch a printing agent (Fig. 35) to initiate the transmitting when the general printer driver is selected as the destination printer.” (Office Action, p.4). Applicants respectfully disagree.

Claim 1 recites separate and different elements of an application, a general printer driver, and a printing agent. The Iwata reference, in Fig. 2, discloses application program 100 (corresponding to the application of claim 1), and virtual printer driver 110 (corresponding to the general printer driver of claim 1). Fig. 35 of the Iwata reference, alleged by the Office to be the printing agent different from the printer driver that is launched to perform the transmitting of a query for identification of an available printer when the general printer driver is selected as the destination printer in the print menu, illustrates a user interface of a Distributed Printing

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Properties window. "This dialog box 'Distributed Printing Properties' corresponds to the user interface 116" (para. [0154]). "In the virtual printer driver 110, the properties setting module 113 activates a user interface 116 to set and store various pieces of information required for printing" (para. [0141]). Thus the user interface 116 is not a separate element from the virtual printer driver 110, but rather part of the virtual printer driver 110, as is clearly illustrated in Fig. 3.

Nor does the Distributed Printing Properties window CD12 perform the transmitting of a query for identification of an available printer when the virtual printer driver 110 is selected as the destination printer. With regard to available printers, the Iwata reference teaches merely that "[i]n response to setting a selected group name in the 'Group Name' data input box id111, the names of all the printers belonging to the selected group are shown in the 'Printers' display box id113. In the initial state, the check boxes cbx provided before the respective printer names are all checked. When the operator desires to prohibit output of the print data to a certain printer because of out-of-paper, failure, or any other reason, the operator releases the check in the corresponding check box cbx to exclude the printer from the output resource of the print data" (para. [0295]). There is no disclosure that Distributed Printing Properties window knows anything about the printer status. Were the Distributed Printing Properties window capable of knowing the printer status, it could automatically deselect a printer problem, or at least inform the user through a status message or another dialog box of the problem with a particular printer. Instead, however, the Iwata reference discloses that it is left to the user to be independently aware of the inability of a printer in the group to print, so that the user can then manually deselect that printer in check box cbx.

In addition, there is no disclosure in the Iwata reference that the Distributed Printing Properties window of Fig. 35 pointed to by the Office as the printing agent ever transmits a query for identification of an available printer. There are a variety of manners in which the at least one available printer could be identified. For example, the available physical printers could have been preconfigured such that no such query is required or performed. For example, a known, fixed set of physical printers may be made available in a network system such that no query need

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ever be performed. Furthermore, such a query, if performed, could be performed at a variety of different times. There is no teaching in the Iwata reference, or in the combined references, that such a query is performed at the particular time when the general printer driver is selected as the destination printer in the print menu, as recited in claim 1.

The Office does not cite the Marbry or Neuhard references as teaching these limitations, and Applicants believe these references teach or suggest no such limitations. Nor does the combination of the Iwata and Marbry references suggest such limitations. Therefore, for the reasons discussed herein, the applied references, alone or in combination, do not teach or suggest all of Applicants' claim limitations, and thus the rejection is improper at least for this reason and should be withdrawn.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. In particular, there is no articulated reason with some rational underpinning to modify or combine reference teachings in that there is no need to combine in the teachings of the Marbry and Neuhard references to allow users in the Iwata reference to find and print to a single printer instead of a plurality of printers.

In order to establish a *prima facie* case of obviousness, there must be an articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006). A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.

The Office states that the Iwata, Marbry, and Neuhard references can be combined together in order "to allow users to find and print to a single printer instead of a plurality of printers like in the Iwata reference" (Office Action, p.5).

Applicants disagree. The Iwata reference, standing alone, discloses that users can find and print to a single printer instead of a plurality of printers without requiring any additional

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teachings. The Printer window WN1 (Fig. 5), in addition to the "Distributed Printing" icon IC4 that corresponds to virtual printer driver 110, also contains "icons IC1, IC2, and IC3 representing the real printer drivers 130, 140, and 150 individually provided for the respective types of the printers 60, 70, and 80." If the user desired to print on a single one of printers 60, 70, 80, then in the Printer Name data input box id21 of Printer dialog box WN3 the user would merely select "LP-100" (for printer 60), "LP-200" (for printer 70), or "LP-300" (for printer 80), instead of selecting "Distributed Printing" for the virtual printer driver.

Therefore, the reason provided by the Office for combining the teachings of the Iwata, Marbry, and Neuhard references lacks the rational underpinning required for validly combining these references. Consequently, this rationale impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Because the Office has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, it is improper to combine the Iwata, Marbry, and Neuhard references and the rejection under 103(a) should be withdrawn.

Furthermore, there is no reasonable expectation of success in modifying the reference or combining reference teachings in that the proposed combination of the Iwata and Marbry references would produce a seemingly inoperative device that could not properly form the intermediate print file. With regard to obviousness, it has been held that:

"If references taken in combination would produce a 'seemingly inoperative device', we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness" *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 101 (Fed. Cir. 2001).

Here, combining the Iwata, Marbry, and Neuhard references would result in an inoperative device. As a result, at least the Iwata reference, the Marbry reference, or both of these references teach away from combination with the other.

Claim 1 recites that a file used to convert print data into a format specific to a selected physical printer is downloaded from a server after a single selected physical printer is identified



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to receive the print job. With regard to the operation of the Iwata reference, the Office identifies Fig. 5, item IC4 as the virtual printer driver (Office Action, p.4). This is incorrect; item IC4 is merely an icon. Instead, virtual printer driver 110 (Fig. 2) of the reference corresponds to the general printer driver recited in claim 1. The Office further states (later, in the rejection of claim 31) that "Figs. 16 item S500 and P[315] discloses that the distributed printing utility does convert data to a specific format for a printer" (Office Action, p.7). Accordingly, the distributed printing utility 120 of the Iwata reference corresponds to the file recited in claim 1 that is downloaded from the server. However, the distributed printing utility 120 also provides performance information about printers 60, 70, 80 to module 114 of the virtual printer driver 110 (para. [0138]-[0140]). This performance information is required in order to identify which physical printer or printers among the group of available printers should receive the print job (para. [0136]-[0138]), and in order for the application program 100 to "convert the generated video data into print data adequate for the printer (the virtual printer) based on the input performance information" (para. [0142]). Since it would not be possible for the distributed printing utility 120 to provide the performance information about printers 60, 70, 80 until the distributed printing utility 120 has already been downloaded into, and is being executed by, the client computer, the Iwata reference teaches that the downloading of the distributed printing utility 120 is performed before selecting the identified physical printer(s) to receive the print job, not after the selecting as required by claim 1.

The Office cites the Marbry reference as teaching (in Fig. 3, and at col. 3, lines 44-65) the limitations of selecting a single one of the identified physical printers to receive the print job, and, after the selecting, downloading from the server a file used to convert print data into a format specific to the selected physical printer (Office Action, p.4). However, combining such features of the Marbry reference with the Iwata reference would result in an inoperative device, because the Iwata reference requires that the downloaded server file (distributed printing utility 120) already be in place before the physical printer(s) that will receive the print job are selected. If the downloaded server file were not in place before the physical printer or printers to receive

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the print job are selected, the Iwata system would be inoperative because the performance information about printers 60,70,80 could not be provided to the virtual printer driver 110. Without knowing the performance information, the virtual printer drive 110 cannot properly form the intermediate print file (para. [0201]-[0203]). Therefore, the combined references would result in a seemingly inoperative device, and there is no reasonable expectation of success in modifying the reference or combining reference teachings.

Because the combination proposed by the Office would result in an inoperative device, the Office has failed to establish a prima facie case of obviousness and the rejection under 103(a) should be overruled at least for this reason. Furthermore, because their combination would result in an inoperative device, at least the Iwata and Marbry references teach away from combination with each other. Any suggestion or motivation to modify the Iwata reference in the manner necessary to render claim 1 obvious could be possible only in hindsight and in light of Applicants' own teachings.

Independent claims 9, 15, and 23 each recite limitations similar to those of claim 1, discussed above. Therefore, for similar reasons as explained heretofore with regard to claim 1, the applied references do not teach or suggest all of Applicants' claim limitations, and the combined references produce an inoperative device and the references teach away from the combination. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 9, 15, and 23, and their corresponding dependent claims 13-14, 16, 20-22, and 25-27, is improper at least for this reason and should be withdrawn.

The rejection of independent claim 31, and its dependent claim 36, is respectfully traversed for at least the following reasons. Claim 31 recites:

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"31. (Currently amended) A method of determining information regarding at least one printer available to receive a print job from a client computer, comprising:  
providing a general printer driver on the client computer accessible as a destination printer in a print menu of an application executed by the client computer;  
selecting the general printer driver as the destination printer directly from the application;  
responsive to the selecting, launching from the general printer driver a printing agent on the client computer, the printing agent different from the general printer driver;  
transmitting a query from the printing agent to a server via a network for an identification of the at least one available printer;  
receiving at the client computer an identification of the at least one available printer from the server in response to the query;  
selecting, via the general printer driver, a single one of the at least one available printer to print the print job; and  
after selecting the printer, downloading from the server to the client computer a file configured to convert the print job into a format specific to the selected printer; and  
printing the print job on the selected printer using the general printer driver and the downloaded file." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

With regard to a first limitation of (a) transmitting a query from a printing agent to a server via a network for an identification of the at least one available printer (b) after launching the printing agent on the client computer from a general printer driver different from the printing agent, the Office states that Fig. 35 of the Iwata reference is the printing agent and that these limitations are taught by Fig. 35, item id113 of the Iwata reference (Office Action, p.6). Applicants respectfully disagree.

The Iwata reference discloses that "[t]he 'Printers' display box id113 shows the names of the printers belonging to the currently selected group in the 'Group Name' data input box id111" (para. [0239]). "The 'Group Name' data input box id131 is used to input the name of the selected group of printers. ... The 'Printers Belonging to' display box id133 shows printers belonging to the selected group. The 'Printers Not Belonging to' display box id134 shows printers that are not included in the selected group among a large number of preset printer names" (para. [0243]). "The operator selects a desired one out of the printer names shown in the

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'Printers Not Belonging to' display box id134 and clicks an 'Add' button id135. The selected printer name is then transferred to the 'Printers Belonging to' display box id133" (para. [0244]).

First, nowhere does the Iwata reference teach or suggest how the set of printers listed in boxes id133, id134 are identified. There are a number of manners in which the at least one available printer could be identified without performing the steps recited in claim 31. For example, the available physical printers could have been preconfigured such that no such query is required or performed. As another example, a known, fixed set of physical printers may be made available in a network system such that no query need ever be performed.

Second, even assuming, arguendo, and which Applicants do not concede, that a query is somehow performed, there is no teaching or suggestion that the query is transmitted after the general printer driver is selected as the destination printer and the printing agent is launched, as required by claim 31. Since the general printer driver can be selected as the destination printer for multiple print jobs at various times when the user is executing the application, the one-time query to predetermine the available printers would necessarily have been performed at some different, earlier time.

The Office does not cite either the Marbry reference or the Neuhard references as teaching or suggesting these limitations, and Applicants believe that these references in combination with each other and with the Iwata reference teach or suggest no such limitations, for similar reasons as have been discussed previously with regard to claim 1.

With regard to a second limitation that a printing agent - different from the application and the general printer driver - is launched responsive to the general printer driver being selected as the destination printer, and then transmits a query for identification of an available printer to a server, the Office points to Fig. 35 as a printing agent (Office Action, p.6). Applicants respectfully disagree.

Claim 31 recites separate elements of an application, a general printer driver, and a printing agent. In Fig. 2, the Iwata reference discloses application program 100 (i.e. application),

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and virtual printer driver 110 (i.e. general printer driver). Fig. 35 of the Iwata reference illustrates a user interface of a Distributed Printing Properties window. "This dialog box 'Distributed Printing Properties' corresponds to the user interface 116" (para. [0154]). "In the virtual printer driver 110, the properties setting module 113 activates a user interface 116 to set and store various pieces of information required for printing" (para. [0141]). Thus the user interface 116 is not a separate element from the virtual printer driver 110, but rather part of the virtual printer driver 110, as is clearly illustrated in Fig. 3.

Nor does the Distributed Printing Properties window CD12 initiate the transmitting of a query for identification of an available printer when the virtual printer driver 110 is selected as the destination printer. With regard to available printers, the Iwata reference teaches merely that "[i]n response to setting a selected group name in the 'Group Name' data input box id111, the names of all the printers belonging to the selected group are shown in the 'Printers' display box id113. In the initial state, the check boxes cbx provided before the respective printer names are all checked. When the operator desires to prohibit output of the print data to a certain printer because of out-of-paper, failure, or any other reason, the operator releases the check in the corresponding check box cbx to exclude the printer from the output resource of the print data" (para. [0295]). There is no disclosure that Distributed Printing Properties window knows anything about the printer status. Were the Distributed Printing Properties window capable of knowing the printer status, it could automatically deselect a printer problem, or at least inform the user through a status message or another dialog box of the problem with a particular printer. Instead, however, the Iwata reference discloses that it is left to the user to be independently aware of the inability of a printer in the group to print, so that the user can then manually deselect that printer in check box cbx.

The Office does not cite either the Marbry reference or the Neuhard references as teaching or suggesting these limitations, and Applicants believe that these references in combination with each other and with the Iwata reference teach or suggest no such limitations, for similar reasons as have been discussed previously with regard to claim 1.

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With regard to a third limitation of, after selecting a single printer, downloading from the server to the client computer a file configured to convert the print job into a format specific to the selected printer, the Office identifies the distributed printing utility 120 of the reference as the element of the Iwata reference that corresponds to the file recited in claim 31 that is downloaded from the server (Office Action, p.6). The Office further states that "Figs. 16 item S500 and P[315] discloses that the distributed printing utility does convert data to a specific format for a printer" (Office Action, p.7). Applicants respectfully disagree.

The distributed printing utility 120 also provides performance information about printers 60, 70, 80 to module 114 of the virtual printer driver 110 (para. [0138]-[0140]). This performance information is required in order to identify which physical printer or printers among the group of available printers should receive the print job (para. [0136]-[0138]), and in order for the application program 100 to "convert the generated video data into print data adequate for the printer (the virtual printer) based on the input performance information" (para. [0142]). However, since it would not be possible for the distributed printing utility 120 to provide the performance information about printers 60, 70, 80 until the distributed printing utility 120 has already been downloaded into, and is being executed by, the client computer, the Iwata reference teaches that any downloading of the distributed printing utility 120 must necessarily have been performed before selecting the identified physical printer(s) to receive the print job, not after the selecting as required by claim 31.

The Office does not cite either the Marbry reference or the Neuhard references as teaching or suggesting these limitations, and Applicants believe that these references in combination with each other and with the Iwata reference teach or suggest no such limitations, for similar reasons as have been discussed previously with regard to claim 1.

Therefore, for the reasons discussed herein, the applied references, alone or in combination, do not teach or suggest all of Applicants' claim limitations, and thus the rejection is improper at least for this reason and should be withdrawn.

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Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. In particular, for similar reasons as explained heretofore with reference to claim 1, there is no articulated reason with some rational underpinning to modify or combine reference teachings in that there is no need to combine in the teachings of the Marbry and Neuhard references to allow users in the Iwata reference to find and print to a single printer instead of a plurality of printers. Consequently, the Office's rationale impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Because the Office has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, the Office has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) should be overruled at least for this reason.

In addition, the Office has not established a *prima facie* case of obviousness at least because there is no reasonable expectation of success in modifying the reference or combining reference teachings in that the proposed combination of the Iwata and Marbry references would produce a seemingly inoperative device that could not properly form the intermediate print file. Because the combination proposed by the Office would result in an inoperative device for similar reasons as explained heretofore with reference to claim 1, the Office has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) of claim 31 should be overruled at least for this reason. Furthermore, because their combination would result in an inoperative device, the Iwata and Marbry references teach away from combination with each other. Any suggestion or motivation to modify the Iwata reference in the manner necessary to render claim 31 obvious could be possible only in hindsight and in light of Applicants' own teachings.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for this reason and

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should be withdrawn.

Claims 30 and 35 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 6,335,795 to Neuhard et al. ("Neuhard"). Applicants respectfully traverse the rejection and request reconsideration.

The rejection of independent claim 30, and its dependent claim 35, is respectfully traversed for at least the following reasons. Claim 30 recites:

"30. (Currently amended) A method of determining information regarding at least one printer available to receive a print job from a client computer, comprising:  
calling a general printer driver, through which the print job is passed, directly from an application executed by the client computer;  
transmitting a query from the client computer to a server via a network for an identification of the at least one available printer;  
receiving the identification of the at least one available printer from the server;  
downloading a file from the server used to convert print data into a format specific to a selected one of the at least one available printer; and  
wherein the general printer driver is accessible as a destination printer in a print menu of the application, and wherein the application is configured to launch a printing agent different from the general printer driver to perform the transmitting when the general printer driver is selected as the destination printer in the print menu." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants' claim limitations.

With regard to the feature of an application being configured to launch a printing agent different from the general printer driver to perform the transmitting of a query from the client computer to a server for identification of an available printer when the general printer driver is selected as the destination printer in the print menu, the Office admits that the Iwata reference does not transmit a query, but states that "Neuhard discloses ... that clients can query a server for available printers" (Office Action, p.12). However, the cited references, taken in combination, fail to teach or suggest a complete construction of this feature of claim 30. In particular, the Neuhard reference fails to teach or suggest the limitation that the general printer driver is selected



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as the destination printer in a print menu of the application. The InfoPrint Submit job ticket software has no print menu at all. Instead, the reference teaches that “the user may ... submit the job ticket 40 to the printer services manager 6 using the Save and Submit Job functions displayed in the Ticket submenu 80” (col. 8, ln. 64-67; emphasis added). However, to whatever extent, if any, that the Ticket submenu may, arguendo, be considered to be a print menu, the Save and Submit job function cannot be executed until after the fields on pages 70a-e (including Print page 70b, Fig. 5a) have been filled in; and it is during the process of filling in these fields that the status object 182 queries the InfoPrint MPC server 6. In addition, because the Neuhard reference fails to teach or suggest the limitation that the general printer driver is selected as the destination printer in a print menu of the application, it cannot teach or suggest that the query is transmitted when the general printer driver is selected as the destination printer.

In the rejection of claim 30, the Office fails to identify which element of the references is considered to be the printing agent, which makes it difficult for Applicants to respond. However, since the previously-discussed rejection of claim 1 stated that the Iwata reference is “configured to launch a printing agent (Fig. 35) to initiate the transmitting when the general printer driver is selected as the destination printer” (Office Action, p.4), Applicants respond on that basis and respectfully disagree.

Claim 30 recites separate and different elements of an application, a general printer driver, and a printing agent. The Iwata reference, in Fig. 2, discloses application program 100 (corresponding to the application of claim 1), and virtual printer driver 110 (corresponding to the general printer driver of claim 1). Fig. 35 of the Iwata reference, alleged by the Office to be the printing agent different from the printer driver that is launched to perform the transmitting of a query for identification of an available printer when the general printer driver is selected as the destination printer in the print menu, illustrates a user interface of a Distributed Printing Properties window. “This dialog box ‘Distributed Printing Properties’ corresponds to the user interface 116” (para. [0154]). “In the virtual printer driver 110, the properties setting module 113 activates a user interface 116 to set and store various pieces of information required for printing”

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(para. [0141]). Thus the user interface 116 is not a separate element from the virtual printer driver 110, but rather part of the virtual printer driver 110, as is clearly illustrated in Fig. 3.

Nor does the Distributed Printing Properties window CD12 perform the transmitting of a query for identification of an available printer when the virtual printer driver 110 is selected as the destination printer. With regard to available printers, the Iwata reference teaches merely that "[i]n response to setting a selected group name in the 'Group Name' data input box id111, the names of all the printers belonging to the selected group are shown in the 'Printers' display box id113. In the initial state, the check boxes cbx provided before the respective printer names are all checked. When the operator desires to prohibit output of the print data to a certain printer because of out-of-paper, failure, or any other reason, the operator releases the check in the corresponding check box cbx to exclude the printer from the output resource of the print data" (para. [0295]). There is no disclosure that Distributed Printing Properties window knows anything about the printer status. Were the Distributed Printing Properties window capable of knowing the printer status, it could automatically deselect a printer problem, or at least inform the user through a status message or another dialog box of the problem with a particular printer. Instead, however, the Iwata reference discloses that it is left to the user to be independently aware of the inability of a printer in the group to print, so that the user can then manually deselect that printer in check box cbx.

In addition, there is no disclosure in the Iwata reference that the Distributed Printing Properties window of Fig. 35 pointed to by the Office as the printing agent ever transmits a query for identification of an available printer. There are a variety of manners in which the at least one available printer could be identified. For example, the available physical printers could have been preconfigured such that no such query is required or performed. For example, a known, fixed set of physical printers may be made available in a network system such that no query need ever be performed. Furthermore, such a query, if performed, could be performed at a variety of different times. There is no teaching in the Iwata reference, or in the combined references, that such a query is performed at the particular time when the general printer driver is selected as the

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destination printer in the print menu, as recited in claim 1.

The Office does not cite the Neuhard reference as teaching these limitations, and Applicants believe these references teach or suggest no such limitations. Nor does the combination of the references suggest such limitations. Therefore, for the reasons discussed herein, the applied references, alone or in combination, do not teach or suggest all of Applicants' claim limitations, and thus the rejection is improper at least for this reason and should be withdrawn.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. In particular, there is no articulated reason with some rational underpinning to modify or combine reference teachings in that there is no need to combine in the teachings of the Neuhard reference to allow users in the Iwata reference to find and print to a single printer instead of a plurality of printers.

While the Office makes no statement in the rejection of claim 31 as to why the Iwata and Neuhard references can be combined, in the rejection of claim 1 the Office states that the Iwata and Neuhard references can be combined together in order "to allow users to find and print to a single printer instead of a plurality of printers like in the Iwata reference" (Office Action, p.5). Applicants disagree, for similar reasons as have been previously discussed with reference to claim 1, in that the Iwata reference, standing alone, discloses that users can find and print to a single printer instead of a plurality of printers without requiring any additional teachings. Therefore, the reason provided by the Office for combining the teachings of the Iwata and Neuhard references lacks the rational underpinning required for validly combining these references. Consequently, this rationale impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Because the Office has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, it is improper to combine the Iwata and Neuhard references and the rejection under 103(a) should

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be withdrawn.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for this reason and should be withdrawn.

Claims 3 and 17 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. Patent Application Publication No. 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. Patent No. 5,692,111 to Marbry et al. ("Marbry") in view of U.S. patent 6,335,795 to Neuhard et al. ("Neuhard") and further in view of Official Notice. Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of these claims on independent claims 1 and 15 respectively, whose reasons for allowability over the Iwata, Marbry, and Neuhard references have been discussed heretofore. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 4-5, 11-12, 18-19, and 24 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 5,692,111 to Marbry et al. ("Marbry") in view of U.S. patent 6,335,795 to Neuhard et al. ("Neuhard") and further in view of U.S. patent 5,580,177 to Gase et al. ("Gase"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of these claims on one of independent claims 1, 9, 15, and 23, whose reasons for allowability over the Iwata, Marbry, and Neuhard references have been discussed heretofore and against which the Gase reference has not been cited.

In addition, there is no articulated reason with some rational underpinning to modify or combine reference teachings of the Gase reference with the Iwata, Marbry, and Neuhard references. The Office states that the Gase reference can be combined with the other references

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in order "to have the most current driver available for compatibility and efficiency reasons" (Office Action, p.10).

Applicants disagree. The Office states that the Gase reference "has the ability to overwrite a printer driver with a newer one ... The printer driver would read on as a printer description file." (Office Action, p.9; emphasis added). However, Applicants' invention is not directed to overwriting an older version of a printer description file 68' for printer A with a newer version of the printer description file 68' for the same printer A. Instead, Applicants' invention is directed to overwriting the printer description file 68' for printer A with a different printer description file 68' for printer B.

Therefore, the reason provided by the Office for combining the teachings of the Gase reference with the Iwata and Marbry references lacks the rational underpinning required for validly combining these references. Consequently, this rationale impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Because the Office has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, the Office has failed to establish a prima facie case of obviousness and the rejection under 103(a) should be overruled at least for this reason.

### Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Office is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

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Respectfully submitted,



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6/3/08

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